

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Jonathan D. Root et al.

Customer No.: 28075

Serial No.: 10/699,727

Examiner: Uyen T. Ho

Filed: November 3, 2003

Group Art Unit: 3731

For: PERCUTANEOUS CATHETER AND GUIDEWIRE FOR FILTERING DURING
ABLATION OF MYOCARDIAL OR VASCULAR TISSUE

Docket No.: 1001.1426103

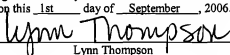
Confirmation No.: 3544

PREAPPEAL BRIEF REQUEST FOR REVIEW

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CERTIFICATE FOR ELECTRONIC TRANSMISSION: The undersigned hereby certifies that this paper or papers, as described herein, are being electronically transmitted to the U.S. Patent and Trademark Office on this 1st day of September, 2006.

By


Lynn Thompson

Appellant respectfully requests a Pre-Appeal Brief Review of the pending application, and assert that the Examiner has made clear errors in prosecuting this application. Favorable reconsideration is respectfully requested.

Claims 37-55 stand rejected under 35 U.S.C. §103(a) as unpatentable over Barbut et al. (U.S. Patent No. 5,997,557) as well as Barbut et al. (U.S. Patent No. 5,997,557) in view of Winston et al. (U.S. Patent No. 6,228,076). It is Appellant's understanding that the previously-raised double patenting rejections have been withdrawn in light of the Terminal Disclaimers previously filed.

The claimed invention describes a percutaneous guidance catheter system that includes an elongate member and an expandable filter attached to the elongate member. The expandable filter has a proximal edge that is attached to the elongate member and a

distal edge that extends distally from a distal end of the elongate member. The proximal edge of the expandable filter is attached to the elongate member at a position that is proximal of the distal end of the elongate member. In other words, the distal end of the elongate member is disposed within the expandable filter.

The cited art does not show this physical configuration. The primary reference includes Figures in which the entire filter is positioned well proximal of the distal end of the catheter to which the filter is mounted. The primary reference includes Figures in which the entire filter extends distally of the distal end of the catheter to which it is mounted. Barbut et al. do not disclose the claimed invention.

The Examiner has asserted that the position of the expandable filter relative to the distal end of the elongate member is nothing more than design choice. Appellant respectfully disagrees with several aspects of the Examiner's position.

For one, the Examiner has stated (in the Advisory Action mailed June 28, 2006) that "Since Barbut do not address the location of the attachment as claimed in the detail description of '557, Examiner considers that it would be matter of design choice...". This is an incorrect assertion. One of skill in the art would consider Barbut et al. as teaching relative positions corresponding to that shown in their drawings, i.e. a picture is worth a thousand words. It is not appropriate for the Examiner to ignore what is clearly shown in the drawings of the primary reference simply because the detailed description of the primary reference does not waste words describing what is abundantly clear in the drawings themselves.

Moreover, for a change to be considered nothing more than mere design choice, the skilled practitioner will recognize that such a change must be superficial, or cosmetic, providing no real effect on function or desired properties. In the present situation, the claimed spatial relationship between the expandable filter and the elongate member does in fact provide performance advantages. As a result, the claimed spatial relationship cannot be considered as mere design choice.

For example, many therapeutic devices are quite flexible. By positioning the filter as claimed, there is a smaller distance between the distal end of the elongate member and a therapeutic site positioned at or near the area defined by the proximal edge of the expandable filter. One of skill in the art will recognize that by shortening this

distance, a relatively greater length of the therapeutic device will remain within the elongate member and thus the therapeutic device will be better supported by the elongate member. This is a substantial, non-superficial advantage that cannot be considered as mere design choice.

Further, the M.P.E.P. clearly states that there must be a motivation provided to make the suggested modification. In particular, M.P.E.P. §2144.04(VI)(C) reads, in part:

“The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims ... is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant’s specification, to make the necessary changes in the reference device.” *Ex parte Chicago Rawhide Mfg. Co.*, 223 U.S.P.Q. 351, 353 (Bd. Pat. App. & Inter. 1984).

In this instance, Barbut et al. do not provide any motivation, suggestion or reason to position the expandable filter relative to the elongate member in any configuration other than the configurations that are clearly shown in the Barbut et al. drawings. Certainly, Barbut et al. provide no motivation, suggestion or reason to provide the claimed spatial relationship between the expandable filter and the elongate member.

As is well-known, one of the requirements of a *prima facie* obviousness rejection is that there must be motivation to either modify the single reference or combine the plural references in order to meet the claimed invention. At a minimum, the Examiner has failed to satisfy this requirement. Merely asserting “design choice” does not provide the necessary motivation.

As noted above, the primary reference, Barbut et al., neither discloses the claimed spatial relationship between the expandable filter and the elongate member nor provides any motivation to one of skill in the art to make the modifications necessary to meet the claimed invention. The secondary reference, Winston et al., fails to remedy the noted shortcomings of the primary reference by providing either the missing elements or the missing motivation to modify.

As there is no motivation to either modify the primary reference or to combine with the secondary reference to meet the claimed invention, the Examiner has failed to

establish a proper *prima facie* obviousness rejection. At a minimum, this is a clear error made by the Examiner. Favorable reconsideration is respectfully requested.

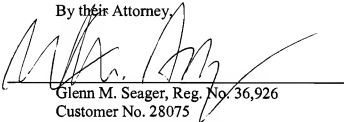
Reexamination and reconsideration are respectfully requested. It is respectfully submitted that all pending claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

JONATHAN D. ROOT ET AL.

By their Attorney,

Date: Sept. 1, 2006


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